REMARKS

All pending claims in the present application have been finally rejected in the Office Action of July 20, 2005 (the Office Action). The claims have been rejected under the judicially created doctrine of obviousness type double patenting over claims 39-50 of co-pending Application No. 09/558,923, and rejected under 35 U.S.C. §103(a) as being unpatentable in view of Dasan, U.S. Patent 5,761,662, and further in view of Huang et al. (Huang), U.S. Patent Application Publication No. US 2002/0091697. For the reasons specified herein and below, applicant respectfully requests reconsideration and removal of the rejections, consideration of newly presented claims 48-57, and timely allowance of this application.

Non-art Rejection – Provisional Double Patenting

Claims 32-47 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 39-50 of copending Application No. 09/558,923. Applicant respectfully traverses this rejection. Applicant asserts that the method of managing a server to provide Internet content and functionality to a user of a computing device disclosed and claimed in the present application would not be obvious to one of ordinary skill in the art in light of the disclosure directed to a method of coordinating the operation of software components, on a user's computer, which are authored in a Web-based computer language such that they operate to display content outside of a web browser application, to thereby allow a content provider to side-step the constraints on presentation of the content imposed by traditional web browser user interfaces, as disclosed in Application No. 09/558,923. However, as the rejection is provisional, and at the present time neither this

case nor Application No. 09/558,923 have been afforded an indication of allowance, Applicant reserves leave for filing additional arguments and actions for a future date.

Rejections under 35 USC §103

Claims 32-47 have been rejected under 35 USC §103(a) as being unpatentable in view of Dasan, U.S. Patent 5,761,662, and further in view of Huang et al. (Huang), U.S. Patent Application Publication No. US 2002/0091697. At the outset of this response, applicant offers a discussion of the general teachings of the present application and the cited references. Following this, a more specific discussion is presented on a claim-by-claim basis, highlighting where specific claim limitations differ from Dasan and Huang.

The present invention is directed to a method and system for providing certain Internet (or web) content and functionality to a user together with a user interface in which the content is viewed at the user's workstation. Importantly, while the content is of a form which may be viewed by a web browser application, instead according to the present invention the content is caused to be displayed in the user interface outside of and separate from a web browser application.

The nature of the user interface (its look and feel, its size, its location, its controls, its functionality, etc.) is specified to the user by way of a definition, and is a function of the type of content being provided. The definition also includes a software component which operates on content in some way. The customized user interface in which the content is displayed, together with the controls and other functionality associated with that interface, are referred to as a networked information monitor or NIM, in the specification. The user interfaces operating on a user's computing device are operated in conjunction with a

manager for such interfaces, which is itself a program (or process) executed on the computing device. No web browser program or instance of a web browser program is required to render or interact with the user interface. A manager program provides certain functionality to the user interface, such as code parsing, control functionality, etc., so that each user interface need only focus on and contain code for the unique attributes of that interface. As a simplified example, the user interface may appear as a dedicated frame on a computer desktop in the image of a small map for indicting the current local weather, the definition being computer programming code for rendering same and its controls on the user's desktop, the functionality may be programming code which operates to obtain the current local weather for display and cause the display of the current local weather, and the content may be the current local weather obtained, for example, from a designated website.

In general, the nature of the user interface is a function of the content to be displayed, as in a map to show the location of a weather forecast. Thus, content providers (who are generally unassociated with the provider of the system for managing the various user interfaces) are provided with the tools and ability to define a user interface which best suits the content they seek to present. Accordingly, the nature of the user interfaces may vary from content to content. Optionally, there may be common attributes to the various user interfaces provided by content providers, as might be determined by a distributor of the content-functionality-interface packages (and provided by the user interface manager program). But such commonality does not hide the uniqueness of the user interfaces specific to the content they are designed to display.

Finally, the NIMs (user interfaces and associated functionality) may be provided from a server (or other such centralized source)r, which manages their attributes, maintains their

most current versions, and which is able to add content and additional user interfaces. Communications with the server involve a user transmitting a user profile, so that the server is able to determine which NIMs the user has previously selected, determine whether updated NIMs are available, and deliver any such updated NIMs and possibly additional content to the user. For example, a user may be logged into such a server, and in response be provided with some or all of: updated look and feel for previously requested NIMs, newly requested NIMs, a list of suggested NIMs based on the user's profile, additional content such as advertisements or the like, etc.

In other words, the present invention is directed to computer software objects which are operable on a user's computer, which are authored in a Web-based computer language, and which display content outside of a web browser application, to thereby allow a content provider to side-step the constraints on presentation of the content imposed by traditional web browser user interfaces. The software objects are web-based applications designed to run separate and apart from a web browser application. The objects include functionality and appearance appropriate for specific content, without being constrained to display the content within the frame of a web browser user interface. The claims of the present application are directed to different facets of this overall focus. Therefore, if the combination of the cited references is proper, they should suggest making such a combination with the goal to obtain such software objects, authored in a Web-based computer language, yet display content outside of a web browser application, with functionality and appearance selectable for particular content they are designed to display.

This is in stark contrast to the teachings of the cited references. Dasan teaches a method and structure for generating a personal newspaper. According to Dasan, a user

establishes a profile, which is a list of topics of interest, and a list of web sites at which to look for the topics of interest. The system examines those sites for items containing the identified topics of interest, then presents those items for display in the user's browser window. The code and the process performed by the code are resident on a server (other than the user's computer). Profile editing options and results are displayed on the user's computer.

Huang discloses the design and functioning of a virtual desktop. A user may create a desktop on a remote computer, which may be accessed by communications via the Internet. The user is then able to access the remote computer and send commands that are processed by the remote computer. The results of such commands are the opening of folders to display either additional folders or documents, or the opening of documents, each within a browser window.

While these broad statements of the functioning of the present invention and the cited references help us understand how the invention and references are conceptually distinct, it is axiomatic that patentable differences must be based in the language of the claims. Accordingly, following is a discussion of the specific rejections, and how and where the language found in the claims of the present application differ from that found in the cited references.

Claims 32 and 39

Initially, claim 32 has been amended herein to recite "retrieving information usable by the computing device ... wherein the information includes instructions for invoking a computing device resident process executable outside of a Web browser" (claim 32, lines 4-

7, as amended, and e.g., specification as filed, page 9, lines 15-17), and further "a definition that defines at least in part a functionality and an appearance of a user interface outside of a Web browser and within which the results of the computing device resident process are presented" (claim 32, lines 8-10, as amended, and e.g., specification as filed, page 20, lines 19-21). Applicant respectfully submits that neither Dasan nor Huang alone, nor the combination of the two references, teach, disclose or suggest such computing device resident process executable outside of a Web browser.

Dasan specifically displays all data within browser windows (e.g., col. 3, lines 62-64), as opposed to a user interface outside of a Web browser. Dasan also performs all functions as server-resident processes (e.g., col. 4, lines 42-44), as opposed to computing-device resident processes.

Likewise, all windows opened according to the Huang teachings are browser windows (e.g., paragraph 54, lines 3-7), and all functions are server-resident processes (e.g., paragraph 49). Contrary to the assertions of the Office Action, since a window (e.g., window 436) according to the teachings of Huang is opened simply by clicking on a URL link, that window must be a browser window (albeit, shown with the navigation and other controls hidden).

Furthermore, there is no suggestion in either the Dasan or Huang references to modify their teachings to provide: (1) computing device resident processes executable outside of a browser window, nor (2) a definition that defines at least in part a functionality and an appearance of a user interface outside of a Web browser and within which the results of the computing device resident process are presented. "Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed

invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed Cir. 1992)." M.P.E.P. § 2143.01 (emphasis added). And while applicant asserts that, contrary to the assumption in the Office Action, there is no motivation nor suggestion in either reference to combine one with the other, and that therefore making such a combination is in fact improper, even if such a combination were permissible it would still not disclose or suggest the invention of claim 32. Thus, applicant asserts that the rejection of claim 32 should be reconsidered and removed.

Claim 39 has likewise been amended hereby. Salient language includes: (1) "retrieving data that is programmed in a format readable by a Web browser program, the data comprising instructions for invoking a computing device resident process and content data to be displayed at the computing device outside of a window of a Web browser program in response to execution of said computing device resident process" (claim 39, lines 4-7, as amended, and e.g., specification as filed, page 9, lines 15-17), and (2) a definition that defines at least in part a functionality and an appearance of a user interface outside of a Web browser and within which the results of the computing device resident process are presented" (claim 39, lines 7-10, as amended, and e.g., specification as filed, page 20, lines 19-21). Once again, there is no teaching, disclosure or suggestion in Dasan nor Huang of: (1) computing device resident processes, nor (2) a definition that defines at least in part a functionality and an appearance of a user interface outside of a Web browser. Nor is there any suggestion in the references to modify their teachings to provide these features. Accordingly, neither Dasan nor Huang render claim 39 obvious. And while applicant asserts

that, contrary to the assumption in the Office Action, there is no motivation nor suggestion in either reference to combine one with the other, even if such a combination were permissible it would still not disclose or suggest these features found in claim 39. Thus, applicant asserts that the rejection of claim 32 should be reconsidered and removed.

Thus, for the reasons stated above, applicant asserts that claims 32 and 39 are patentably distinct from the cited references, taken alone or in combination, and accordingly requests reconsideration and allowance thereof.

Claims 33 and 34

Claims 33 and 34 have been cancelled herein, and accordingly are not further discussed.

Claims 35 and 40

Claims 35 and 40 have been rejected in light of the assertion that Huang discloses, "for each user (computing device), the network provides different kinds of folder icons (definitions) that some of the folder icons such as public folder icons can be opened by the user." Claims 35 and 40 have been amended herein to each recite that "at least a portion of the user interface is a frame within which the results of the computing device resident process are presented" (claims 35 and 40, lines 2-3, as amended).

Applicant requests reconsideration of this rejection on two grounds. First, Claim 35 depends from and contains all of the limitations of claim 32. Since claim 32 has been demonstrated to be non-obvious over the cited references, claim 35 must differ from those references for at least the same reasons. Likewise, claim 40 depends from and contains all

of the limitation of claim 39. And since claim 39 has been shown above to be non-obvious over Dasan and Huang, claim 40 must be non-obvious over those references for at least the same reasons.

Second, while it may be true, as asserted in the Office Action, that according to Huang some of the public folder icons can be opened, Huang (and Dasan for that matter) are silent about the definition being of a user interface, and that a portion of that user interface is a frame outside of a Web browser in which the results of the computing-device resident process is presented. Claims 35 and 40 each include, in part: "at least a portion of the user interface is a frame within which the results of the computing device resident process are presented" (claims 35 and 40, lines 1-3, as amended). While the Office Action asserts that window 436 is outside the browser, it is in fact a browser window itself (although illustrated with navigation and other controls hidden), as is evident from the fact that it is opened by clicking on a URL link (e.g., paragraph 53 and 54). Thus, since the window opened in response to clicking on the hyperlink is a browser window, the user interface is defined by the browser and not by the "definition that defines at least in part a functionality and an appearance of a user interface outside of a Web browser and within which the results of the computing device resident process are presented" (claim 32, lines 6-10, from which claim 35 depend; and claim 39, lines 8-10, from which claim 40 depends).

Thus, for the reasons stated above, applicant asserts that claims 35 and 40 are patentably distinct from the cited references, taken alone or in combination, and accordingly requests reconsideration and allowance thereof.

Claims 36 and 41

Claims 36 and 41 have been rejected in light of the assertion that Huang discloses, that the "user clicks on icon for news and information, then a list of available URL links to other web sites is displayed on a window 436 (this window is outside of the web browser), each link is associated with the URL of another web page ... such that by selecting the link with the mouse, the user can move to a web page corresponding to the elected link." Initially, claim 36 depends from and contains all of the limitations of claim 32. Since claim 32 has been demonstrated to be non-obvious over the cited references, claim 36 must differ from those references for at least the same reasons. Likewise, claim 41 depends from and contains all of the limitation of claim 39. And since claim 39 has been shown above to be non-obvious over Dasan and Huang, claim 40 must be non-obvious over those references for at least the same reasons.

However, claims 36 and 41 have been amended herein to each recite that "at least a portion of the definition fully describes a functionality and an appearance of a frame within which the results of the computing device resident process are presented" (claims 36 and 41, lines 2-3, as amended). This highlights several differences between the claimed invention and the cited references. For example, Huang (and Dasan for that matter) are silent about the definition functionality and appearance of a frame, and specifically of such a definition being outside of a Web browser in which the results of the computing-device resident process is presented. There is absolutely no disclosure in either cited reference which details a definition including both functionality and appearance of a frame. And again, while the Office Action asserts that window 436 is outside the browser, it is in fact a browser window itself (although illustrated with navigation and other controls hidden), as is evident

from the fact that it is opened by clicking on a URL link (e.g., paragraph 53 and 54). Therefore, the references fail to teach, disclose or suggest that the frame is outside of a browser window.

Thus, for the reasons stated above, applicant asserts that claims 36 and 41 are patentably distinct from the cited references, taken alone or in combination, and accordingly applicant requests reconsideration and allowance thereof.

Claims 37 and 42

The Office Action states that claims 37 and 42 are rejected in light of Dasan and Huang which disclose that the definition is provided by a Web content provider, thereby enabling the Web content provider to control at least in part a functionality and an appearance of the frame rendered on the computing device (citing Dasan, Abstract, and col. 6, line 20 – col. 7, line 41, and col. 8, lines 4-39). While claims 37 and 42 are not amended herein, claims on which they depend, 36 and 39 respectively, have been so amended. Claim 36 has been demonstrated above to be non-obvious over the cited references. Accordingly, claim 37 must differ from those references for at least the same reasons. Likewise, claim 42 depends from and contains all of the limitation of claim 39. And since claim 39 has been shown above to be non-obvious over Dasan and Huang, claim 42 must be non-obvious over those references for at least the same reasons.

Furthermore, according to Dasan, news items are retrieved from specified websites, and aggregated, filtered, and formatted, before being provided to the user. Despite the lengthy sections cited in the Office Action, there is no mention therein of the Web content provider (e.g., the news sources) also providing a definition for the frame. In fact, the system

of Dasan converts the retrieved news items into ASCII files (col. 8, lines 8-11), thus dissociating any format the content provider originally intended to be associated with the content text. Dasan then aggregates the unformatted text from various such content providers into a single file, then applies its own formatting prior to delivering the newly-formatted content ("personalized newspaper") to the user. Importantly, in the process of producing the personalized newspaper, the system of Dasan substitutes its own format for that of the content provider, and accordingly teaches against the Web content provider providing both the content and a definition of a user interface in which the content is to be displayed. Therefore, the references fail to teach, disclose or suggest the invention claimed in claims 37 and 42. For the reasons stated above, applicant asserts that claims 37 and 42 are patentably distinct from the cited references, taken alone or in combination, and accordingly applicant requests reconsideration and allowance thereof.

Claim 38

Claim 38 has been rejected in the Office Action, in which it is asserted that the Dasan (Abstract) teaches the content data is provided by the Web content provider. Claim 38 has been amended herein to recite that the "computing device resident process is provided by the Web content provider" (claim 38, lines 1-2, as amended). Applicant respectfully asserts that the cited references, alone as well as in combination with one another, do not teach, disclose, nor suggest such instructions for invoking a computing device resident process, let alone that such instructions for invoking a computing device resident process is provided by the Web content provider. Nor do the references teach these features in combination with the features of the claims upon which claim 38 depends. Accordingly, applicant requests reconsideration and allowance of this claim.

Claim 43

Claim 43 has been rejected in the Office Action, in which it is asserted that Dasan and Huang disclose that the content data and definitions are provided by the Web content provider, thereby enabling the user interface to integrate seamlessly with the content data (Dasan, col. 5, line 53 – col. 6, line 52). Applicant makes two points here. First, claim 43 has been amended herein to recite "the computing device resident process, content data, and the definition are provided by the Web content provider, thereby enabling the user interface to integrate seamlessly with the results of the computing device resident process and content data" (claim 43, lines 1-4). Applicant respectfully asserts that the cited references, alone as well as in combination with one another, do not teach, disclose, nor suggest that the Web content provider provide the computing device resident process, content data, and the definition. Nor do the cited references teach, disclose, or suggest same in combination with the features of the claims upon which claim 43 depends.

Second, as has been previously discussed, Dasan teaches us to convert a targeted Web-based news item from its native format to ASCII, thereby dissociating the text and its format, then aggregating the unformatted text with the unformatted text extracted from other Web-based news items, and finally delivering same to the user in a window defined by the Dasan system. This is very different from the claimed presentation of Web-based content (e.g., the news items of Dasan) in a frame defined by the content provider (e.g., defined by the news item provider of Dasan).

Applicant respectfully asserts that the cited references, alone as well as in combination with one another, do not teach, disclose, nor suggest the features of claim 43,

nor such features in combination with the features of the claims upon which claim 43 depends. Accordingly, applicant requests reconsideration and allowance of this claim.

Claims 44-47

Claims 44-47 have been rejected in the Office Action, citing the arguments applied against claims 32-43. Claim 44 has been amended to recite, in part, "the second address is usable by the computer device to retrieve a definition that defines at least in part a functionality, which is other than hyperlink functionality" (claim 44, lines 6-8, as amended). Applicant asserts that this amendment distinguishes claim 44, and the claims depending directly and indirectly thereon, from the cited references. As has been previously discussed, Dasan teaches the collection of news items (content) from third party Web sites, converting the text of those news items into ASCII, aggregating all such text together, then applying a format to the aggregated text to create a personalized newspaper. The format applied to the text creates headings for each item. These headings become "anchors", which are effectively links to the related text (Dasan, col. 8, lines 16-21). Thus, the only functionality provided by the user interface of Dasan is linking. Similarly, Huang teaches creating a Web page that appears to a user to be the desktop of a computing device. On the desktop are icons, such as folders and documents. Each folder icon is a link to a list of other folder or document icons. Each document icon is a link to formatted text. Invoking any functionality provided by Huang is accomplished by clicking on a link, or icon (Huang, paragraphs 53-54). Accordingly, each cited reference teaches only the functionality of hyperlinking, while claim 44 as amended is limited to functionality which is other than hyperlinking. Therefore, Applicant respectfully asserts that the cited references, alone as well as in combination with

one another, do not teach, disclose, nor suggest the features of claim 44. Accordingly, applicant requests reconsideration and allowance of this claim.

Claims 45-47 each depend from, and therefore contain all of the limitations of, claim 44. As it has been demonstrated that claim 44 differs from the cited references, alone and in combination, claims 45-47 must differ from those references for at least the reasons claim 44 differs therefrom. Thus, without further discussing the specific limitations of each of claims 45-47, applicant respectfully asserts that the cited references, alone as well as in combination with one another, do not teach, disclose, nor suggest the features of claims 45-47, nor such features in combination with the features of the claims upon which claims 45-47 depend. Accordingly, applicant requests reconsideration and allowance of these claims.

New claims 48-57

Applicant has added new claims 48 through 57 herein. Support for these claims may be found throughout the application as filed. According to one embodiment of the present invention, the first software component has been described in the specification as a home networked information monitor (NIM). This home NIM "is capable of accessing each of the NIMs that are represented in the processed user profile" (specification, page 9, lines 16-17). The very reason for this teaching (coordinating the display of content in various frames outside of a Web browser) is outside the scope of the teachings of the cited references. But even assuming some conceptual relationship between the teachings of the references and the claimed invention, the cited references fail to specifically teach this facet of the present invention: namely, the ability to display Web-based content, in a frame outside of a web browser, with a user interface defined by the web content provider.

Therefore, applicant asserts that for at least the reasons recited above, claims 48 through 57 patentably distinguish from Dasan and Huang, taken alone or in combination with one another. Accordingly, applicant requests consideration and allowance of claims 48-57.

The combination of Dasan and Huang

The Office seeks to combine the teachings of Dasan and Huang in order to demonstrate the obviousness of the claims in the present application. Applicant asserts that making such a combination is improper. In establishing a *prima facie* case of obviousness relying on the combination of two references, the references must disclose a reason or motivation to combine their teachings to make the claimed invention. In re Dillon, 919 F. 2d 688, 692-93, 16 USPQ2d 1897, 1901 (Fed. Cir. 1990)(en banc), cert denied, 500 U.S. 904 (1991). Furthermore, it is not enough to show that there is some abstract motivation for combining references. Rather, a person of ordinary skill in the art must be provided some motivation by the references to combine their teachings in the particular manner claimed. In re Koltzab, 217 F.3d 1365, 1371 (Fed. Cir. 2000). "In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination *in the manner claimed*." In re Rouffet, 149 F.3d 1350, 1357 (Fed. Cir. 1998)(emphasis added).

As previously discussed, the present invention is directed to computer software objects which are operable on a user's computer, which are authored in a Web-based computer language, and which display content outside of a web browser application, to thereby allow a content provider to side-step the constraints on presentation of the content imposed by traditional web browser user interfaces. In other words, the software objects are

web-based applications designed to run separate and apart from a web browser application. The objects include functionality and appearance appropriate for specific content, without being constrained to display the content within the frame of a web browser user interface. The claims of the present application are directed to different facets of this overall focus. Therefore, if the combination of the cited references is proper, they should suggest making such a combination with the goal to obtain such software objects, authored in a Web-based computer language, yet display content outside of a web browser application, with functionality and appearance selectable for particular content they are designed to display.

However, a careful reading of the references does not lead to any such suggestion. In support of the combination, the Office Action makes these assertions:

1) Dasan and Huang are in the same field of endeavor, and

2) The virtual desktop disclosed by Huang is similar to Dasan's method for retrieving information based on a personalized newspaper.

In addition to identifying no suggestion in the references for how one might make the combination, or even motivation to do so, the assertions are in fact incorrect. Dasan is directed to the collection and display of news information from disparate web sites based on a user profile, while Huang is directed to a personal web page which can act as a virtual desktop for a user, so that the organization of the user's data is consistent regardless of which machine on which the user views the data. With all respect for the examiner, these fields of endeavor are not the same. Nor is a virtual desktop similar to the retrieval and display of news items from disparate web sites. While each may present information accessible by clicking on links, there is where the similarity ends. The desktop of Huang is

used to organize files and documents (including links) obtained or created by the user. The newspaper of Dasan autonomously obtains, removes format from, and organizes news items based on user entered preferences, then delivers them for display.

Accordingly, the references fail to provide any reason for making their combination, let alone how one skilled in the art might do so to obtain the claimed invention. Thus, applicant asserts that the proposed combination of the references is improper and cannot support a finding of prima facie obviousness of the claims of the present application.

CONCLUSION

In view of the foregoing, applicant believes all claims pending in this application now distinguish over the cited art and are in condition for allowance. The issuance of a formal Notice of Allowance of this application at the earliest possible date is respectfully requested.

If the Examiner believes that a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-941-4470.

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